

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of: Harold R. Garner

Serial No.: 09/776,202

Filed: February 2, 2001

Art Unit: 1634

Examiner: Betty J. Forman

For: DIGITAL OPTICAL CHEMISTRY MICROMIRROR



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Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT AND AMENDMENT

Dear Sir:

Applicant hereby respectfully submits this Reply to the Official Action, dated May 13, 2002, due for reply on or before June 13, 2002. Included herewith is a Petition for a One (1) Month Extension of time and the appropriate fee sufficient to extent the response deadline up to and including July 15, 2002 (as July 13, falls on a Saturday.) In view of the following restriction with traverse, consideration and allowance of the claims pending in this Application are respectfully requested. If any additional fees are due, the Commissioner is hereby authorized to charge any fee required to our Deposit Account No. 07-0153.

In the Claims:

Please cancel claims 39 through 61 and claims 70 through 79.

RESTRICTION

Claims 39 through 79 are subject to a restriction requirement under 35 U.S.C. § 121. The Action identifies a restriction to four groups of inventions. Applicants hereby elect Group III, claims 62 through 69, with traverse, for continued prosecution. Claims 39 through 61 and claims 70 through 79 have been cancelled.

TRAVERSE

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween. MPEP § 808. [Emphasis in the original]. With regard to the first aspect, the action fails to provide a reason as to why the inventions identified in the Official Action are distinct.

With regard to the second aspect, the reasons under MPEP § 808 given by the Examiner for insisting upon exercising his authority under 35 U.S.C. § 121 to require restriction must be reasons approved by the Commissioner. The reasons approved by the Commissioner are set out in MPEP § 803: (1) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i); and (2) there must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and 808.02). Examiner must provide reasons and/or examples to support conclusions. MPEP § 803.


For purposes of the initial requirement, a serious burden on the examiner may be shown, *prima facie*, if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 803. Applicant respectfully asserts that the Examiner has failed to make a *prima facie* case that restriction is required. The Official Action to which this reply is responsive provides no reason as to why the inventions as claimed are either independent or distinct; it merely provides a conclusion that such is the case. Therefore, Applicant respectfully asserts that the *prima facie* requirements of MPEP § 803 have not been met.

CONCLUSION

Applicant provisionally elects Group III, claims 62 through 69 for continued prosecution. For the reasons set forth above, Applicant respectfully requests reconsideration by the Examiner and withdrawal of the restriction/election requirement. Applicant submits that claims 62 through 69, are fully patentable. Favorable consideration and allowance of the application is therefore respectfully requested. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: July 12, 2002.

Respectfully submitted,
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